


ATTORNEY DOCKET NO.: 2002832-0002
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Sosin	Examiner:	Blau
Appeal No.:	2005-2680	Art Unit:	3711
Serial No.:	09/248,515		
Filing Date:	February 8, 1999		
Title:	GOLF CLUB AND METHOD OF DESIGN		

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P.O. Box 1450
Alexandria, VA 22313-1450

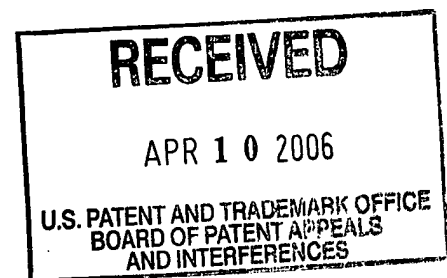
Sir:

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<u>April 10, 2006</u> Date	 Signature
	Mary Wilson Typed or Printed Name of person signing certificate

REQUEST FOR REHEARING

Appellant respectfully requests rehearsing of the Decision on Appeal No. 2005-2680 ("Decision") that was mailed on February 10, 2006 in the above-references case. The deadline for filing a Request for Rehearing ("Request") is April 10, 2006. The filing of this Request on April 10, 2006 is therefore timely.

Remarks begin on page 2 of this paper.



REMARKS

Appellant respectfully requests rehearing of the Decision *only* with regard to claim 53. Claim 53 had been rejected under 35 U.S.C. § 102(b) as anticipated by Thompson, and also under 35 U.S.C. § 103 as obvious over Ahn in view of Hirose and Scheie. The Decision reversed the obviousness rejection, but maintained the anticipation rejection. Appellant respectfully submit that the anticipation rejection is improper and should be removed.

In maintaining the rejection of claim 53 for anticipation by Thompson, the Decision misapprehends or overlooks at least three important points. First, the Decision misapprehends the teachings of Thompson. Second, the Decision misapplies the legal standards required of the Hampford and Loesch declarations. Third, the Decision disregards portions of the Loesch Declaration that clearly establish that a person of ordinary skill in the art *would not* see in Thompson the teachings attributed to it by the Examiner.

The rejection of claim 53 over Thompson

Claim 53 recites:

53. An iron-type golf club comprising:

a head having a face with a single design loft and a sole;

a single straight hosel; and

a single straight shaft connected to the head via the hosel, the connection arranged so that the shaft forms a non-zero lean angle, which non-zero lean angle is greater than 3 and less than 10 degrees, with the vertical when the head rests on its sole so that its face achieves its design loft.

Thompson is a United States patent that describes *the head of* an iron-type golf club that includes a "downwardly tapered keel". Nowhere in Thompson is there *any discussion at all* of the connection of this head to a shaft. The rejection of claim 53 over Thompson is based entirely on Fig. 2, which is a particular elevation of the same head shown in all four of the other Figures in the patent. Fig. 2 depicts Thompson's inventive club head and also shows a portion of a shaft extending from the head. The depicted shaft portion is not in a vertical orientation.

Errors in the Decision

The Decision finds that the Hampford and Loesch Declaration “are ineffective to rebut the clear teachings of Thompson”. This single statement reflects both a misapprehension of the teachings of Thompson; and a misapplication of the legal standard to be met by the Hampford and Loesch Declarations. The subsequent statement that “at best, the Hampford and Loesch declarations establish that neither declarant was aware of a club being designed and manufactures having a shaft with a non-zero lean angle” overlooks important statements in at least the Loesch Declaration. For each of these reasons, the present Request for Rehearing should be granted.

1. *Any teachings in Thompson relating to lean angle are ambiguous at best*

First, there are no *clear* teachings in Thompson for the Hampford and Loesch declarations to rebut. Fig. 2 itself does not include any indication of any angle (e.g., design loft, angle between the shaft and the face, etc.), or indeed even any indication that it is intended to represent an accurate, scaled drawing. Fig. 2 is not mentioned in the specification other than in the Drawing Description. There is no discussion of how the depicted shaft is connected to the head, and indeed there is no description of any characteristic of the head other than the keel and a weighting bore established to adjust for the weight of the keel.

Thus, the “teachings” of Thompson are not *clear* or *explicit* with regard to the presence or absence of a lean angle in Fig. 2.

Indeed, even if one scours Thompson looking for a teaching of the presence or absence of a lean angle, no clear guidance is found. The only relevant teaching present anywhere in Thompson comes with reference to a different figure, Fig. 4. Fig. 4 is said to represent the same golf club head as Fig. 2. Fig. 4, however, shows no shaft or hosel at all. Fig. 4 does show an angle, α , observed between the face of the golf club head and the vertical. This angle is said to be “between about 30 and 40 degrees” (column 2, lines 11-16 of Thompson; see also page 4 of the Decision). There is no indication that the golf club head shown in Fig. 4 is positioned at its design loft. There is also no explicit indication that the golf club head is in the same position as that shown in Fig. 2, although by eyeball they appear to be close. The golf club head shown in Fig. 4 is said to be a wedge. As Appellant has previously established in this case, standard

wedges have a design loft between about 45-64 degrees. Thus, if the α shown in Fig. 4 is intended to be a design loft, the depicted club is a very unusual wedge. If the α shown in Fig. 4 is not intended to be a design loft but rather to represent just the position of the head, then Fig. 4 depicts a standard wedge in a delofted position.

Appellant has argued that, of these two choices, the latter (i.e., a standard wedge in a delofted position) is more likely than the former. The Decision rejects this argument by pointing out that others (namely Hirose) sometimes describe non-standard wedges. Appellant does not challenge that Hirose describes a wedge with a non-standard design loft. However, Appellant respectfully points out that *the entire disclosure* of Hirose is directed to describing that non-standard angle. Thompson, by contrast, makes *no mention at all* of any desire to describe a wedge with a non-standard design loft, or a non-standard attachment of shaft to head. Appellant therefore submits that it remains *more likely* that Thompson was depicting a de-lofted standard wedge in Fig. 4 than a completely non-standard wedge. Resolution of this issue, however, is *not required* in order to grant the present Request for Rehearing, and to reverse the rejection over Thompson because, if the present discussion establishes nothing else, it certainly establishes that the teachings of Thompson with regard to lean angle *are not clear*.

2. *Hampford and Loesch Declarations need not rebut*

Given that Thompson does not explicitly describe or explain anything about the head/shaft connection depicted in Fig. 2, this must be considered an “unexplained feature” of that figure. Case law requires that unexplained features of a drawing must be evaluated for what they *reasonably* disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 USPQ 500 (CCPA 1979). Furthermore, accidental disclosure in a drawing is only available as a reference against a later patent claim if that disclosure is “clearly made”. *In re Seid*, 161 F.2d 229 (CAFC 1947). In the present case, therefore, it was error for the Board to require that the Hampford and Loesch Declarations rebut a clear teaching. Those Declarations were required only to explain how a person of ordinary skill in the art would understand an *ambiguous* teaching.

3. *The Loesch Declaration establishes that Thompson does not teach a lean angle.*

The Loesch Declaration states:

"I would therefore expect that, consistent with standard practice, Thompson intended no lean angle. I appreciate that the Figure itself could be construed to depict a lean angle, but I understand this to reflect an imprecise rendition of a three-dimensional object in two dimensions rather than an intended deviation from the norm."

Paragraph 4. Thus, the Loesch Declaration clearly establishes that Fig. 2 of Thompson *does not* teach a golf club with a lean angle, even to a person of extraordinary skill in the art.

The Decision apparently overlooked this portion of the Loesch declaration. The Decision dismisses both the Hampford and Loesch declarations by stating that they establish nothing more than "that neither declarant was aware of a golf club being designed and manufactured having a shaft with a non-zero lean angle before the invention of the appellant". Appellant agrees that the Hampford and Loesch declarations establish this point, but that is not all that they establish. As illustrated above, the Loesch declaration also clearly establishes that Thompson's Fig. 2 would not be understood by those skilled in the art to teach a lean angle. In light of this, the rejection must be reversed.

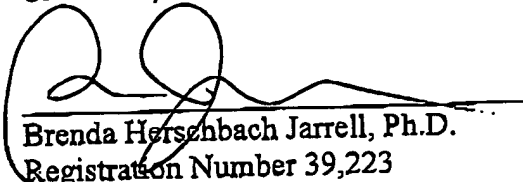
Conclusion

For all of these reasons, Appellant respectfully submits that the Decision on Appeal issued February 10, 2006 contains several misapprehends or overlooks several important points; the present Request for Rehearing should be granted and claim 53 should be allowed.

Respectfully submitted,

CHOATE, HALL & STEWART LLP

Dated: April 10, 2006



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From Mary Wilson for Brenda Herschbach Jarrell, Ph.D. **Number of Pages** 8 (including this page)

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Comments

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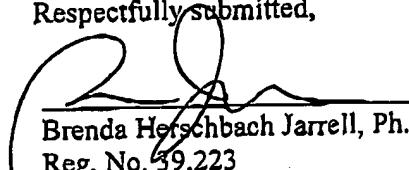
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Title: GOLF CLUB AND METHOD OF DESIGN

In response to the Decision on Appeal No. 2005-2680 that was mailed on February 10, 2006,
please find the following:

- 1) Transmittal (1 pg); and
- 2) Request for Rehearing (6 pp).

Respectfully submitted,


Brenda Herschbach Jarrell, Ph.D.
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Enclosed please find the following documents:

- (1) Request for Rehearing (6 pp).

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